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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/071,664 05/01/98 SHAFFER

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EXAMINER

WM01/1024

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INTELLECTUAL PROPERTY DEPARTMENT
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ART UNIT

PAPER NUMBER

2642

DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/071,664

Applicant(s)

Shaffer et al

Examiner

Bing Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 13, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 18, and 19 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18, and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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DETAILED ACTION

1. This action is in response to applicant's response filed on Aug 13, 2001. Claims 1-16 and 18-19 are now pending in the present application. **This action is made final.**

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 1-16 and 18-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Smiley et al (US Pat No 5,982,863), of record.

Regarding claim 1, with respect to Figure 1, Smiley et al teach a method for providing an automated call connection system comprising the steps of:

a patient 14 (first user) contacting a Doctor Care Unit (DCU) server 18 (call server) (col 3, ln 54-55);

the patient 14 (first user) requesting the DCU server 18 to deliver a call back request to a doctor (second user) by pressing number "1" on his telephone (col 4, ln 36-38);

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the DCU server 18 notifies the doctor (second user) that he has call back request (sending the call back request to the doctor (second user)) (col 6, ln 20-23);

the DCU server 18 prompting the doctor (second user) whether to call the patient 14 (first user) back (col 6, ln 24-36);

the doctor (second user) optionally signaling acceptance of the call back request to the DCU server 18 by pressing number "1" on his telephone (col 6, ln 43-44); and

if the doctor (second user) clicks on button 312 (signals) to accept the call back request, the DCU server 18 automatically dials the patient 14 for attempting to connect the patient 14 (first user) and the doctor (second user) (Fig 6, element 312; col 6, ln 43-44 and col 7, ln 18-21).

Regarding claim 2, Smiley et al teach a method of providing an automated call connection system as defined in claim 1, further comprising the step of: the DCU server 18 using a separate packet based network to determine if the second user is ready to accept the call back request (fig. 2 and col 2, ln 37-ln 63).

Regarding claim 3, Smiley et al teach a method of providing an automated call connection system as defined in claim 1, further comprising the step of: the DCU server 18 bypassing call toll charges by using a packet based network for the sending of call back requests (fig. 2 and col 2, ln 37-ln 63).

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Regarding claim 4, Smiley et al teach a method of providing an automated call connection system as defined in claim 1, in which the DCU server 18 initiates a call from a device of the doctor (second user) (Col 4, ln 37-39 and col 7, ln 18-21).

Regarding claim 5, Smiley et al teach a method of providing an automated call connection system as defined in claim 1, wherein the patient 14 (first user) may request for call back via at least one of an E-mail message using computer 14c, a facsimile using fax machine 14b (Fig 1 and col 1, ln 12-26).

Regarding claim 6, Smiley et al teach a method of providing an automated call connection system as defined in claim 1, wherein the prompt is provided to the doctor (second user) on a telephone display (Fig 6 and col 6, ln 20-ln 31).

Regarding claim 7, Smiley et al teach a method of providing an automated call connection system as defined in claim 1, wherein the patient 14 (first user) uses a voice mail system to request the call back (col 7, ln 27-ln 43).

Regarding claim 8, Smiley et al teach a method of providing an automated call connection system as defined in claim 1, further comprising the step of:

maintaining a connection between the first user and the second user for a predetermined period of time (col 4, ln 66 col 5, ln 7);

wherein the predetermined period of time is specified by the first user (col 4, ln 66 col 5, ln 7).

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Regarding claim 9, Smiley et al teach a method of providing an automated call connection system as defined in claim 1, wherein the first user is provided with the option of placing a message in a voice mail system (col 7, ln 27-ln 43).

Regarding claim 10, Smiley et al teach a method of providing an automated call connection system as defined in claim 1, wherein a personal digital assistant is used by the patient 14 (first user) to request the call back (col 2, ln 64-ln 11).

Regarding claim 11, Smiley et al teach a system for providing an automated call connection comprising:

- a first user input for initiating and sending a call back request (fig. 5 and col 6, ln 11-ln 49);

- a second user output for receiving the call back request (fig. 5 and col 6, ln 11-ln 49);

- a server for transferring the call back request from the first user output device to the second user output device and for prompting the second user whether to call back the first user, and, if the second user signals to the network connection to return the call, for automatically attempting to connect the first user and the second user (fig. 5 and col 6, ln 11-ln 49).

Regarding claim 12, Smiley et al teach a system for providing an automated call connection as defined in claim 11, wherein the server connects to a separate packet

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based network, the separate packet based network determining if the second user is ready to accept the call back request (fig. 2 and col 2, ln 37-ln 63).

Regarding claim 13, Smiley et al teach a system for providing an automated call connection as defined in claim 12, wherein call toll charges are bypassed through use of the packet based network (fig. 2 and col 2, ln 37-ln 63).

Regarding claim 14, Smiley et al teach a system for providing an automated call connection as defined in claim 11, wherein the first user input is at least one of a personal data assistant, a computer, a telephone and a facsimile machine (fig. 2 and col 2, ln 37-ln 63).

Regarding claim 15, Smiley et al teach a system for providing an automated call connection as defined in claim 11, wherein the second user output is at least one of a personal data assistant, a computer, a telephone and a facsimile machine (fig. 2 and col 2, ln 37-ln 63).

Regarding claim 16, Smiley et al teach a system for providing an automated call connection as defined in claim 11, wherein the first user call back request is sent via at least one of an E-mail message, a page and a facsimile (Fig 1 and col 1, ln 12-ln 26).

Regarding claim 18, Smiley et al teach a system for providing an automated call connection as defined in claim 11, wherein the first user uses a voice mail system to request the call back (col 7, ln 27-ln 43).

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Regarding claim 19, Smiley et al teach a system for providing an automated call connection as defined in claim 11, wherein the network connection is maintained for a predetermined period of time, and the predetermined period of time is specified by the first user (col 4, ln 66 col 5, ln 7).

Response to Arguments

4. Applicant's arguments with respect to claims 1-16 and 18-19 have been considered but are moot in view of the new ground(s) of rejection.

As to Applicant's response dated March 10, 2000 attached to Paper No. 5, Examiner agrees with Applicant that the call back in Smiley is not implemented immediately right after receiving call back request from a patient, but is by appointment. However, with respect to new amended claims pending for examination that the Applicant recently submitted, Examiner could not find anywhere in the recited pending claims that requires the call back call has to be made immediately right after the call back request is received and accepted. Due to this reason, without requiring the call back has to be made immediately right after the call back request is received and accepted, Smiley teaches the invention exactly as recited amended claims.

Therefore, Examiner respectfully sustains Smiley for making final rejection which is enclosed herein.

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Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Moll (US Pat No. 5,027,387) discloses a system and method for reversing direction of a call made by a caller back to such caller by called end user system.

Mashinsky (US Pat No. 6,088,436) discloses an automated callback system.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bing Bui whose telephone number is (703) 308-5858. The examiner can normally be reached on Monday through Thursday from 7:30 to 5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314 and for formal communications intended for entry (please label the response "EXPEDITED PROCEDURE") or for informal or draft communications not intended for entry (please label the response "PROPOSED" or "DRAFT").

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Bing Bui

Patent Examiner

Oct 18, 2001


AHMAD MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600